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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/642,652 | 08/19/2003 | Makoto Namikawa | Q76997 | 3048 |

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EXAMINER

SINGH, ARTI R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/642,652 | Applicant(s) NAMIKAWA ET AL. | |
| | Examiner Ms. Arti Singh | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. The Examiner has carefully considered Applicant's amendments and remarks dated 09/28/05. Applicant's amendments to claims 1-5 have been entered. Applicant's amendments overcome the rejections made in paragraphs 5 and 7 of last office action. All other objections/rejections from the previous office action are maintained and this action is made final.

Response to Arguments

2. Applicant's arguments filed 09/28/05 have been fully considered but they are not persuasive. Applicant's first traversal/remark is that the provisional double patenting rejections be deferred. The Examiner has done so and repeated the rejection and maintained it until a later time the prosecution. Applicant's second and third traversals/remarks deal with the 112-2 rejections set forth in the paragraphs 5 and 7 of the previous office action. These have been overcome by Applicant's amendments and have thus been withdrawn. Applicant's last traversal/remarks deal with the 102(b) art rejection, where Applicant's counsel states that the present invention differs from the one in the patent because their invention is a cleaning sheet comprising a thermoset resin cleaning layer having porosity and that the end uses of both precuts are different. To this the Examiner contends that this may be true, however Applicant uses open ended language like "comprising" which allows other layers to be present, and that as long as all the layers are present the same function could be performed on any surface. Applicant's next traversal/remark is that Applicant's invention in a preferred embodiment comprises of a thermoset resin/a support/ and a thermoplastic adhesive and that the adhesive of claims 3 and 4 are not the same materials. In responding to the structural features of Applicant's remarks, on page two of the instant patent, the

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Patentee describes the drawbacks of the tape/nonwoven structures, and the simple adhesive tapes and that the adhesives would stick to different parts of the cleaning unit thereby hindering the process and reducing the efficiency of cleaning sheet. The reason for adding the porous screen was to stop the "sticking of the adhesive" throughout the process. It should be understood that since the screen is porous there is bound to be some adhesive on the other side of the screen, which meets the structural layers of the preferred embodiment in question. With regard to adhesives not being of the same materials, Applicant is incorrect. Both Applicant and Patentee may use acrylics resins, and thus this traversal is not persuasive.

Information Disclosure Statement (repeated from Non-final dated 03/28/05 and maintained)

3. A proper IDS is still required as stated in the previous office action.

Double Patenting (repeated from Non-final dated 03/28/05 and maintained)

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/297173, 11/000007 & 11/014779. Although the conflicting claims are not identical, they are not patentably distinct from each other because they all appear to be obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102(repeated from Non-final dated 03/28/05 and maintained)

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by EPO 0 930 538 A1 issued to Nitto Denko Corporation.

8. EPO 0 930 538 A1 issued to Nitto Denko Corporation (appears to be the same assignee as Applicant) discloses a cleaning tape for use in cleaning transport surfaces comprising a tape body, upon one side lies an adhesive layer atop of which lies a porous screen (abstract). The porous screen protrudes from a surface of the adhesive layer so that the cleaning tape can show substantially no tackiness [0008]. The tape body can be formed from polyethylene terephthalate [0017], plastic, polypropylene, vinyl chloride, resin impregnated paper,

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synthetic paper [0018] some of which are described by Applicant in their instant specification which alludes one to think that they are equivalent thermoset resins. The materials used for the adhesive layers may include synthetic rubbers including acrylic styrene, silicon and natural rubbers [0021]. The porous screen used is usually a knitted fabric made of polyester [0024].

Furthermore, in claim 7 there are no method limitations other than conveying (using) the composite and thus it has been treated as an article claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 571-272-1483. The examiner can normally be reached on M-F 9-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ms. Arti Singh
Primary Examiner
Art Unit 1771

Ars 12/26/05